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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,279	08/23/2001	Kai C. Su	20007.0016U2	1931

7590 04/04/2003

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EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
1732	6

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/938,279	Applicant(s)	50
Examiner	M. VARGO	Group Art Unit	1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

Responsive to communication(s) filed on \_\_\_\_\_

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

Claim(s) 1-43 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-25 + 27-31 is/are allowed.

Claim(s) XXXXXX 26 + 32-43 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a). Note that declaration refers to serial number 09/931,490, while the proper serial number is 09/938,279.

2. Claims 26 and 32-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32-38 are indefinite in that it is unclear how the strip by itself would function to mold a lens “in cooperation with a front mold and a back mold” as recited in the preamble of claim 32. In essence, it would appear that claim 39 needs to be added into claim 32 to perform the functionality recited in claim 32. In claims 26 and 37, the trademark “KRATON G” should be replaced with generic terminology.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.  
Claims 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Orlosky.

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Orlosky discloses the instant sleeve for molding a lens in cooperation with a front and back mold, the sleeve comprising a body portion having first and second ends (14 and 16), an inner surface and an outer surface, venting and fill ports (54 and 56) formed on the body portion and positioned apart from each other and a recess channel (note recess in gasket body 10 in Figure 4, the recess being formed at the intersection of the tapered inner wall and shoulder 12) on the inner surface of the body that allows communication between the venting and casting port. See column 7, lines 3-30.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cano et al in view of Orlosky.

Cano et al discloses a strip used in the instant manner, the strip essentially lacking a recess channel formed on the inner surface thereof. As noted in paragraph 3, supra, Orlosky discloses such a recess channel on the inside surface of a molding shell, the channel allowing for communication between a fill port and a vent port. It would have been obvious to one of ordinary skill in the art to modify the strip of Cano et al (once the edges have been joined) as taught in Orlosky to enable venting of air from the mold cavity.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 32-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-24 of U.S. Patent No. 6,099,764. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application sets forth the invention in US Patent -764 (ie, the strip with a recess channel) in much broader terms, without the cooperation of the elements as set forth in claims 17-24 of the previous patent.

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7. Claim 43 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,068,464 in view of Orlosky. Previously issued US Patent 6,068,464 claims essentially the instant sleeve lacking the recess channel, which, as noted *supra*, is taught by Orlosky. It would have been obvious to one of ordinary skill in the art to modify the invention of US Patent -464 as taught by Orlosky to facilitate venting of the cavity.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

April 4, 2003

*4/4/03*